



Dkt. #696-PCT-US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Rosen, et al.
U.S. Serial No. : 09/445,054 Examiner: Rebecca Cook
Filed : March 27, 2000 Group Art Unit: 1614
For : METHOD OF TREATING CANCER

Law Offices of Albert Wai-Kit Chan, LLC
World Plaza, Suite 604
141-07 20th Avenue
Whitestone, NY 11357

March 9, 2005

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir/Madam:

COMMUNICATION IN RESPONSE TO MARCH 2, 2005 SUPPLEMENTAL NOTICE OF
ALLOWABILITY

AND

COMMUNICATION TO RESUBMIT A COPY OF THE REFERENCES PREVIOUSLY
SUBMITTED AND CITED IN MAY 24, 2000 INFORMATION DISCLOSURE
STATEMENT FORM (FORM NO. 9)

AND

COMMUNICATION TO SUBMIT WRITTEN RECORD OF MARCH 8, 2005 TELEPHONE
INTERVIEW/CONVERSATIONS WITH THE EXAMINER

This Communication is being submitted in response to the March 2, 2005 Supplemental Notice of Allowability issued by the United States Patent and Trademark Office (USPTO) in connection with the above-identified application. There is no deadline to file this

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Communication. Accordingly, this Communication is being timely submitted.

The Examiner to whom this Application is assigned has issued a Notice of Allowability on September 28, 2004. Applicants have timely paid the Issue Fee on December 22, 2004.

On March 2, 2005, the Examiner issued a Supplemental Notice of Allowability with a copy of the "Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date 8/7/01" attached thereto. Applicants' attorney office received the March 2, 2005 Supplemental Notice of Allowability on March 7, 2005, more than two (2) months after Applicants have paid the Issue Fee.

A copy of the March 2, 2005 Supplemental Notice of Allowability is attached herein as **Exhibit A**.

Applicants have noticed that the Examiner crossed out six (6) references cited in the "Foreign Patent Documents" section and two (2) references cited in "Other Non Patent Literature Documents" section of the Information Disclosure Statement Form attached to the March 2, 2005 Supplemental Notice of Allowability.

Upon reviewing the Applicants' file history, Applicants have found that the Information Disclosure Statement Form attached to the March 2, 2005 Supplemental Notice of Allowability was previously submitted to the USPTO on May 24, 2000. A copy of the May 24, 2000 Information Disclosure Statement, including the First Class Mail Certificate of Mailing dated May 24, 2000 and a copy of the return postcard with the USPTO date-stamp of May 30,

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2000 indicating that ten (10) references were received by the USPTO, is attached herein as **Exhibit B**.

Applicants respectfully maintain that the references cited on the Information Disclosure Statement Form attached to the March 2, 2005 Supplemental Notice of Allowability should not have been crossed out because a copy of the Information Disclosure Statement Form and a copy of each cited reference were timely and properly submitted to the USPTO, as evidenced by the First Class Mail Certificate of Mailing dated May 24, 2000 and the return postcard with the USPTO date-stamp of May 30, 2000.

Alternatively, if the references cited in the Information Disclosure Statement Form attached to the March 2, 2005 Supplemental Notice of Allowability cannot be located in the USPTO's application file; Applicants hereby resubmit a copy of those references, specifically:

(A) Six (6) references cited in the "Foreign Patent Documents" section

- (1) European Patent Application No. 0 856 315 A1, published February 20, 1997, Banyu Pharmaceutical Co., LTD., et al., entitled "Medicinal Composition" **[Exhibit 1]**
- (2) European Patent Application No. 0 618 221 A2, published May 10, 1994, Bristol-Myers Squibb Company, et al., entitled "Heterocyclic Inhibitors of Farnesyl Protein Transferase" **[Exhibit 2]**
- (3) European Patent Application No. 0 670 314 A1, published March 30, 1995, Kyowa Hakko Kogyo Co., LTD., et al., entitled "Farnesyl Transferase Inhibitor" **[Exhibit 3]**

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- (4) International Application Publication No. WO 97/17070, published May 15, 1997, University of Pittsburg, et al., entitled "Inhibitors of Protein Isoprenyl Transferases" [Exhibit 4]
- (5) European Patent Application No. 0 456 180 A1, published November 13, 1991, E.R. Squibb & Sons, Inc., et al., entitled "Farnesyl-protein transferase assay for identifying compounds that block neoplastic transformation" [Exhibit 5]
- (6) International Application Publication No. WO 97/01275, published January 16, 1997, Banyu Pharmaceutical Co., LTD., entitled "Combinations of Inhibitors of Farnesyl-Protein Transferase" [Exhibit 6]

(B) Two (2) references cited in the "Other Non Patent Literature Documents" section

- (7) Moasser, et al., Farnesyl transferase inhibitors cause enhanced mitotic sensitivity to taxol and epothilones, February 1998, Proc. Natl. Acad. Sci. USA, Vol. 95, pp. 1369-1374. [Exhibit 7]
- (8) Danesi, et al., Paclitaxel (Taxol) Inhibits Protein Isoprenylation and Induces Apoptosis in PC-3 Human Prostate Cancer Cells. Molecular Pharmacology, Vol. 47, pp. 1106-1111 (1995). [Exhibit 8]

March 8, 2005 Telephone Conversations with the Examiner

Applicants' undersigned attorney contacted the Examiner on March 8, 2005 to inquire into the reason that the above-mentioned references cited in the Information Disclosure Statement Form attached to the March 2, 2005 Supplemental Notice of Allowability

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were crossed out. The Examiner informed the Applicants' undersigned attorney that the references were crossed out because a copy of the cited references cannot be found in the USPTO's application file. The Examiner has indicated that if Applicants resubmit a copy of the cited references and evidence showing that the Information Disclosure Statement and a copy of the cited references were previously submitted to the USPTO, the Examiner will consider those references.

Conclusion

Accordingly, Applicants attach herewith a clean copy of the Information Disclosure Statement Form that was previously submitted on May 24, 2000 as **Exhibit C**, and respectfully request that the Examiner consider the references attached to this Communication and initial the attached Information Disclosure Statement Form prior to the issuance or publication of the patent.

If a telephone interview would be of assistance in advancing prosecution of the subject application, Applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

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No fee is deemed necessary in connection with the filing of this Amendment/Communication. However, if any fee is required, authorization is given to charge the amount of any such fee to Deposit Account No. 50-1891.

Respectfully submitted,

Albert Wai Kit Chan

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Sir/Madam:

EXPRESS MAIL CERTIFICATE OF MAILING
IN CONNECTION WITH THE ABOVE-IDENTIFIED APPLICATION

"Express Mail" mailing label number: EV 333074525 US

Date of Deposit: March 9, 2005

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. §1.10 on the date indicated above and is addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450


Printed Name: Chih-Sheng Lin

Respectfully submitted,

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